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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,929	01/15/2004	Bernd Simon	TRAUMA 3.0-452	6354
530 7590 02/02/2011 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER SCHAPER, MICHAEL T	
			ART UNIT 3775	PAPER NUMBER
			MAIL DATE 02/02/2011	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/757,929	Applicant(s) SIMON ET AL.	
	Examiner MICHAEL T. SCHAPER	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>29 Nov 10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 29 Nov 2010 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the reference still is not attached. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Response to Arguments

Applicant's arguments with respect to all current claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 renders the claim indefinite because Examiner is unsure whether or not the pair of elongate slots contains the originally claimed slot of claim 8. Examiner will assume that it does, as consistent with the specification and drawings. Amendment is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-8 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Scarborough et al. (US 5928238).

Scarborough discloses a system (10, see FIGS. 1-4) for forming a channel in a bone comprising a guide wire (42+44) having a leading and trailing end; a rotatable boring tool (40+46) having a wall (outer 40) surrounding an axial bore (36) for slidably receiving said guide wire, said tool having a first end including a cutting element (see FIG. 1, distal part of 40) and a drive end (32) adapted to be connected to a power source (20) for rotating said tool to bore into bone, said bore being adapted to permit said guide wire to slide axially through said bore when said tool is connected to said power source

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and while said tool is boring into bone (see FIGS. 2-4), and said wall adjacent said drive end having an elongated opening (50) therethrough in communication with said bore, said elongated opening being adapted to permit viewing of axial sliding movement of said guide wire trailing end during rotation of said boring tool while said tool is connected to said power source and said tool is boring into bone (see FIGS. 2-4); wherein said opening is in the form of an elongated slot (see FIG. 2); wherein the elongated opening has a first end (proximal 50) and a second end (distal 50), the first end being spaced from the drive end of the boring tool, and the second end of the opening being located closer to the cutting element than the first end of the opening (see FIG. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 19-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scarborough et al. (US 5928238).

As to claim 9, Scarborough discloses the claimed invention except for, *i.e.* is silent on, wherein a pair of elongated slots are, *i.e.* an additional slot is, located on opposite sides of said wall.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Scarborough having a plurality of openings, since the mere duplication of the essential working parts of a device involves only routine skill in the art, and the instant application makes it clear that embodiments with one or multiple openings are interchangeable (see ¶21).

As to claims 19-21 and 23, Scarborough discloses a boring tool (10, see FIGS. 1-4) for bone, comprising a shank (40+46) having a rotatable cutting tool (see FIG. 1) at a first distal end thereof, the shank and cutting tool having a cannulation (36) therethrough, the shank having a drive portion (32) at a proximal end thereof, the shank having a radially outwardly extending slideable lock portion (52) between the shank distal end and the drive portion, the lock portion being slideable distally and proximally along the shank (see FIG. 1), the distal end of the shank spaced distally of the lock portion and the drive portion spaced proximally of the lock portion, the shank having a window (50) therein; and a guide wire (42+44) slidably received within the cannulation in the shank and cutting tool and having a trailing end viewable through the windows in the shank (see FIGS. 2-4); wherein the elongated opening has a first end (proximal 50) and a second end (distal 50), the first end being spaced from the drive end of the boring tool, and the second end of the opening being located closer to the cutting element than the first end of the opening (see FIG. 2).

Scarborough discloses the claimed invention except for, *i.e.* is silent on, there being two windows, diametrically opposed and parallel to each other and the cannulation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Scarborough having a plurality of openings, since the mere duplication of the essential working parts of a device involves only routine skill in the art, and the instant application makes it clear that embodiments with one or multiple openings are interchangeable (see ¶21).

Additionally, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to space the openings of Scarborough diametrically because Applicant has not disclosed that this provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Scarborough's device, and applicant's invention, to perform equally well with either the spacing taught by Scarborough or the claimed diametrical spacing because both would perform the same function of viewing the guide wire go up and down the shaft. Therefore, it would have been *prima facie* obvious to modify Scarborough to obtain the invention as specified in claims 19-21 and 23 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Scarborough.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art added to the attached PTO-892 but not relied upon in this action by rejection contain multiple features in both independent claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL T. SCHAPER whose telephone number is (571)270-7413. The examiner can normally be reached on M-F, 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on (571)272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. T. S./
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775